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Attorney Docket No.: 40418-501C01US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT : Blackburn, J.M. *et al.* CONFIRMATION NO. : 4288
SERIAL NUMBER : 09/967,321 EXAMINER : LAM, Amy Y.
FILING DATE : October 1, 2001 ART UNIT : 1641
FOR : METHODS OF MAKING AND USING A PROTEIN ARRAY

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APPLICATION FOR ADJUSTMENT OF PATENT TERM UNDER 37 C.F.R. § 1.705(b)

Applicants request reconsideration of the patent term adjustment under 37 C.F.R. § 1.705(b) to 110 days as of the mailing of the Notice of Allowance. In support of this request, Applicants submit the following statement of facts pursuant to 37 C.F.R. § 1.705(b).

(i) The United States Patent and Trademark Office ("Office") calculated the adjustment under 37 C.F.R. § 1.703 as 509 days (USPTO Delay). However, the correct adjustment under 37 C.F.R. § 1.703 is 633 days, which is the sum of 604 days (delay under 37 C.F.R. § 1.703(a), "the 14-month rule") and 29 days (delay in mailing the Notice of Allowance). The Office used 480 days instead of 604 days in calculating the delay under the 14-month rule. The basis for this latter date is the following:

1. The first action on the merits was mailed March 25, 2004, a delay of 480 days under 37 C.F.R. § 1.703 (a).
2. A second action on the merits was mailed July 27, 2004. This action stated that it was in response to "a letter by Applicant stating that Applicant never received the Office action mailed on March 25, 2004. The Office action of March 25, 2004 was a first action on the merits. However, upon reconsideration, Examiner believes that a restriction requirement is appropriate as set forth below. To expedite prosecution, Examiner is replacing the non-final action of March 25, 2004 with the restriction requirement below since a final action has not been made and Applicant never received the non-final action of March 25th."

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3. On June 10, 2004, the law firm of Sterne Kessler Goldstein Fox sent a letter to the Office memorializing a telephone conference with Examiner Lam on June 9, 2004 and stating that following a status inquiry it was determined that the Office action mailed March 25, 2004 had not been received by Sterne Kessler.
4. On October 14, 2003, a Change of Correspondence Address and a Revocation and Power of Attorney were filed in the subject application removing Sterne Kessler and appointing Mintz Levin Cohn Ferris Glovsky and Popeo, P.C., as the attorney of record.
5. The second action, mailed July 27, 2004, should be treated as the first action on the merits under 37 C.F.R. §1.703 (a) because (i) it expressly stated that it was “replacing” the earlier Office action; (ii) it contained a restriction requirement which had not been made in the earlier Office action and stated that it was made “upon reconsideration” of the case by the Examiner; and (iii) the Examiner erred in communicating with the attorneys of Sterne Kessler, since Sterne Kessler was no longer of record in this case at the time the first office action was issued.
6. Thus, prosecution was delayed in this application through no fault of Applicants’ by an additional 124 days due to the Examiner’s issuance of the July 27, 2004 Office action. Accordingly, the delay under 37 C.F.R. §1.703 (a) should be counted beginning on the day after the date that is fourteen months after the filing date of this application and ending on the date of mailing of the July 27, 2004 Office action, which is a delay of 604 days, not the 480 days used by the Office in its calculations.

(ii) The Office calculated the reduction of patent term under 37 C.F.R. § 1.704, for Applicants’ failure to engage in reasonable efforts to conclude prosecution of the application, as 523 days. Applicants do not dispute this number.

In summary, Applicants request an adjustment of patent term to indicate a total PTA of 110 days, which is the sum of periods under 37 C.F.R. § 1.703(a),(c)-(e) (604 + 29 days), less the sum of the periods under 37 C.F.R. § 1.704 (532 days), or a total of 110 days.

The above-identified application is not subject to a terminal disclaimer. There were no circumstances constituting a failure to engage in reasonable efforts to conclude processing or examination of the application as set forth in 37 C.F.R. § 1.704, other than the circumstances described above.

Applicants reserve the right to request reconsideration of the patent term calculated under 37 C.F.R. § 1.703(b). As of the present time, the delay due to the failure of the Office to issue a patent within three years after the date on which the application was filed is estimated to be 914 days, which is the period from October 3, 2004 (the day after the date that is the three year anniversary of the application filing date) up to and including April 4, 2007 (the day before the date that a Request for Continued Examination was first filed).

Pursuant to 37 C.F.R. § 1.705(b) and § 1.18(e), the fee required for filing this application for patent term adjustment is believed to be \$200.00. Please charge the required fee, and any additional fees due, or credit any overpayment of same, to Deposit Account No. 50-0311, Customer No, 30623, Reference No.:40418-501C01US.

Respectfully submitted,

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